

Attorney Docket: Beiersdorf 653

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-4, 6 and 8-20 are pending in the application.

Reconsideration of the final rejection is requested based on:

- 1) The application should have been allowed due to the Examiner's amendment.
- 2) The finality should be withdrawn because the new reference applied was in response to Examiner's amendment, which was agreed to only because of the presumed and imminent allowance of the application.

Examiner's Amendment is Precedent to Allowance

The undersigned was contact by Examiner Simone on 1 March 2004, with what was very clearly described as an Examiner's amendment. It is emphasized that Examiner's contact at that time was not solicited, but that Examiner took the initiative to contact the undersigned to discuss her suggestions for the Examiner's amendment. The following text from MPEP § 1302.04, is particularly relevant:

The amendment or cancellation of claims by formal examiner's amendment is permitted *when passing an application to issue where these changes have been authorized by applicant (or his/her attorney or agent) in a telephone or personal interview.* The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held. (Emphasis added).

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Examiner contacted the undersigned by telephone to propose an amendment to claims 1 and 23. See attached copy of claims. In response, the undersigned agreed, and contacted the client who approved of the examiner's amendment. See copy of email to client attached hereto. After receiving the client's approval, a confirmatory email was sent to Examiner on 2 March 2004, a copy of which is attached.

It is longstanding practice that an Examiner's amendment is an instrument that is used in good faith to expedite allowance. In accordance with the rules it is improper to issue a rejection after agreement is reached on an examiner's amendment.

The only proper response is to withdraw the rejection.

Finality Should be Withdrawn

It is also pointed out that when asserting new references, a final rejection is not proper if the issues at point have not been established. MPEP § 706.07(a) states,

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

Although Applicant approved of the amendment entered by Examiner, it was done so only on the expectation that the claims were allowed. It was Examiner's amendment and its implied agreement, and not Applicant's amendment that inspired Examiner to make the rejection final.

The finality should be withdrawn.

CONCLUSION

The foregoing remarks support withdrawal of the rejection and allowance of the claims. As stated, it is long held policy that an Examiner's amendment should be used to expedite claims' allowance. Thus, withdrawing the rejection would be in keeping with this rule as stated in the MPEP.

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In addition, the finality of the rejection should be withdrawn. Should it be found that the Examiner's amendment, for some reason, cannot be withdrawn, it is requested that the finality be withdrawn. The new reference was applied based on Examiner's amendment, and therefore Applicants should not be penalized.

Respectfully Submitted,

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Theodore Gottlieb

Typed or printed name of person signing this certificate

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